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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/890,321 | 10/12/2001 | Akira Okazaki | 1776/4066 | 9517 |

7590 09/09/2002
Morgan & Finnegan
345 Park Avenue
New York, NY 10154

EXAMINER

HAMPTON HIGHTOWER, PATRICIA

| ART UNIT | PAPER NUMBER |
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1711
DATE MAILED: 09/09/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-7

Office Action Summary

Application No.

09/890,321

Applicant(s)

A. Okazaki

Examiner

P. Hightower

Group Art Unit

1711

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/12/01; 12/7/01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-7, 11-12, 21-22, 26-27, 31-32, 39-40, 46-47 is/are pending in the application.
55-56, 59-61, 71-73, 82-83, 85, 86
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-7, 11-12, 21-22, 26-27, 31-32, 39-40, 46-47, 55-56, 59-61, is/are rejected.
71-73, 82-83, 85, 86
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
 - ☐ received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☒ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 60
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Information Disclosure Statement

The information disclosure statement filed December 7, 2001 has been considered and has been made of record.

Response to Amendment

The preliminary amendment filed October 12, 2002 in which claims 8-10,13-20,23-25,28-30,38, 41-45,48-54,57-58,62-70,74-81 and 84 were canceled is acknowledged; claims 1-7,11-12,21-22,26-27,31-37,39-40,46-47,55-56,59-61,71-73,82-82 and 85-86 are presently pending.

Abstract

The abstract of the disclosure is objected to because the abstract is too long, it consists of 5 pages and the abstract should be only be no more than a 150 words in paragraph form on a separate sheet. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;

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- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 11-12, 21-22, 26-27, 31-37, 39-40, 46-47, 55-56, 59-61, 71-73, 82-83 and 85-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "curable melamine-type, composite-type, modified by, characterized by" in claims 1-7, 11-12, 21-22, 26-27, 31-37, 39-40, 46-47, 55-56, 59-61, 71-73, 82-83 and 85-86 is a relative terms which render the claims indefinite. The terms "curable melamine-type, composite-type, modified by, characterized by" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Clarification is requested.

Regarding claim 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 11-12, 71-73, 82-83 and 85-86 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 016965 Mitsubishi Gas Chem Co. Inc.

JP 016965 to Mitsubishi Gas Chem Co. Inc., discloses the production of hydroxyalkyl acrylic ester (hydroxyalkyl acrylate) or hydroxyalkyl methacrylic acid ester (hydroxyalkyl methacrylate) modified with caprolactone by reacting the hydroxyalkyl acrylic acid ester or methacrylic acid ester with a lactone in the presence of a catalyst, a polymerization inhibitor and an antioxidant at 70 – 120°C which anticipates the claimed invention. See English language abstract.

Claims 1-7, 11-12, 21-22, 31-37, 55-56, 71-73, 82-83, 85-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al (USP 4,916,254).

Watanabe et al (USP 4,916,254) discloses epsilon-caprolactone modified hydroxyalkyl acrylate or methacrylate prepared in a process comprising synthesizing

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from epsilon-caprolactone and a hydroxyalkyl acrylate or methacrylate in the presence of a stannous halide as a catalyst; wherein the obtained monomer (epsilon-caprolactone-added hydroxyalkyl acrylate or methacrylate) and then copolymerizing the resulting monomer to synthesize a lactone-modified acrylic polyol; which is suitable for coating and photocurable composition anticipates the claimed invention. See abstract; col. 1, lines 28-39, 60-65; col. 2, lines 7-29, 30-32, 63-68; col. 3, lines 1-16, 33-68; col. 4, lines 5-26, 27-60; cols. 5-6; col. 7, lines 1-4, 5-37; col. 8, lines 35-63, 64-68; col. 9, lines 65-68, 18-64; col 10, lines 1-5; the examples; the claims.

Watanabe et al teaches at col. 6, lines 63- col. 7, lines 1-4, by copolymerization of the hydroxyl group containing acrylic or methacrylic ester modified with caprolactone with a radical-polymerizable monomer, there can be obtained an acrylic polyol resin having an excellent reactivity with a crosslinking agent and a high flexibility. The modified ester may be reacted with a polyisocyanate to synthesize a flexible urethane bond-containing, polyfunctional acrylate or methacrylate. The patentee teaches the epsilon-caprolactone-modified hydroxyl (meth)acrylate ester is produced preferably by using a stannous halide (except fluoride) as the catalyst. See col. 7, lines 57-60.

The patentee teaches the hydroxyl group-containing acrylic or methacrylic ester which is to be modified with epsilon-caprolactone includes hydroxyethyl methacrylate, hydroxyethyl acrylate, hydroxypropyl methacrylate ester, hydroxypropyl acrylate, hydroxybutyl methacrylate and hydroxybutyl acrylate and mixtures thereof. See col. 8, lines 64- col. 9, lines 1, 2-50, 51-64.

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The patentee teaches at col. 9, lines 65-68 that the coating copolymer is an acrylic copolymer having hydroxyl groups, and this coating copolymer can be cured with a known crosslinking agent such as amino resin and polyisocyanate.

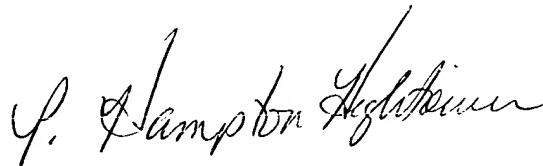
Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references are cited to show the state of the art of flexible primer composition, curable coating compositions and high solids, water-thinnable compositions; Carson, Chang and Temple.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Hightower whose telephone number is (703) 308-2434. The examiner can normally be reached on Monday – Friday from 9:30 A.M. - 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



P. Hightower:evh
August 28, 2002

P. Hampton Hightower
Primary Examiner
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